REMARKS/ARGUMENTS

Claims 11-21 are pending in this application.

Claim Rejections - 35 USC §112:

Claims 11-21 are rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. The rejection is respectfully traversed.

The Office Action recited on pages 2-3, "Without any calculation examples and/or typical values for the variables involved in the equation, one of ordinary skill in the art cannot decipher how the equation would ensure the claimed post-decimal difference. Therefore, the Specification does not enable one of ordinary skill in the art at the time of the invention to use the process of the claimed invention, as it is not clear how the winding ratios are determined to ensure the post decimal difference, at each winding ratio change, is 0.1 at most without undue experimentation." This statement is incorrect, as calculations or values are not required for compliance with the enablement requirement.

The MPEP (2164.02) recites, "Compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, does not turn on whether an example is disclosed. An example may be "working" or "prophetic." A working example is based on work actually performed. A prophetic example describes an embodiment of the invention based on predicted results rather than work actually conducted or results actually achieved."

In the Specification, applicant has clearly provided predicted results in accordance with the graph of Figure 2 and Table 1 on pages 6-7, which both clearly show "the winding ratio is changed in essentially integral steps so that, with each change, the post-decimal point part of the winding ratio will change by 0.1 at the most". Furthermore, paragraph [0036] of the Substitute Specification recites:

"By means of the above-indicated formula, a person skilled in the art is able to determine, from a desired shift d, the winding ratio V that is necessary therefor. In practice, it has turned out to be advantageous for the design of a bobbin with excellent stability that the shift

d is selected such that an overlap of bandlets of approximately ½ a bandlet width b emerges (see Fig. 8 and Fig. 9). A negative algebraic sign of the shift means a "forward-moving" winding."
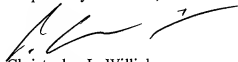
Thus, one skilled in the art would understand that for a desired shift distance, the equation presented would provide the appropriate winding ratio V. Accordingly, under 35 U.S.C. §112, first paragraph, and the MPEP, one commonly skilled in the art would be enabled to practice the claimed invention.

CONCLUSION

In view of the foregoing, applicant submits that this application is in condition for allowance, and a formal notification to that effect at an early date is requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (415) 273-4730 (direct dial).

Respectfully submitted,

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